c) up to 12% added water

d) 0.1 to 1.5% of a C_{12-22} fatty acid or salt

e) the balance being a natural starch.

REMAKRS

Status of Claims:

Claims 12-21 are pending in the application. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

Rejection Under 35 U.S.C. § 103(a):

Claims 12-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayer in view of Tomka.

Where the Examiner proposes a combination that makes a prior art reference inoperable for its intended purpose, the resulting inoperable prior art reference is considered to teach away from the proposed combination, thereby supporting a showing of nonobviousness. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (Finding no suggestion to modify a prior art device where the modification would make the device inoperable for its intended purpose); *TecAir, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 52 USPQ 2d 1294, 1298 (Fed. Cir. 1999) (Holding that because the combination was inoperable for its intended purpose, a jury could reasonably find the patent taught away from the combination); *In re Sponnoble*, 405 F.2d 578, 587 (CCPA 1969)(Holding if where combined, the references would produce a seemingly inoperative device, the references teach away from their combination).

The combination of Mayer and Tomka to reach the present invention is improper because Mayer and Tomka are mutually incompatible for the purposes of their own inventions. The Examiner cites Mayer as teaching preparing and extruding

biodegradable starch blends using unprocessed raw starch. The Examiner acknowledges Mayer does not teach modified starch. The Examiner cites Tomka for the use of modified starch. Mayer specifically recites alleged disadvantages attendant to the use of modified starch (column 1, lines 50-55; column 2, lines 21-27). Mayer's invention is a process for using unmodified starch (column 2, lines 59-67). Tomka specifically relates to modified starch (as cited by the Examiner).

Meyer and Tomka are incompatible for a second reason. Tomka relates to an anhydrous process (column 3, lines 48-50; column 13, lines 1-2). Mayer specifically adds water to give a starting moisture level of 13% (column 3, lines 41-43; Example 1 second table). An anhydrous process is not compatible with a process required to be performed under conditions of 13% moisture.

Examiner's Point 6

The Examiner expressed surprise regarding the Applicant's statement taht ethylene-vinyl alcohol is not a water-soluble polymer. A high proportion of vinyl alcohol is required for ethylene/vinyl alcohol polymers to be water-soluble. Commercial grades of these polymers are not water soluble. Commercially-available ethylene-vinyl alcohol co-polymers are described as being insoluble in water in the accompanying IDS. Claim 1 referred to the water soluble, but commercially unavailable grades.

Conclusion:

In view of the above, consideration and allowance are, therefore, respectfully solicited.

Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

Respectfully submitted,



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APPENDIX

(Amended Claim to show revisions)

17. (Amended) A biodegradable film forming polymer composition which consists of: 8 to 80% of a starch modified to include an hydroxyalkyl C_{2-6} group or modified by reaction with an anhydride of a carboxylic acid

a) 4 to 11 % of a water soluble polymer selected from polyvinylacetate, polyvinyl alcohol [and copolymers of ethylene and vinyl alcohol]

b) 10 to 16% of a polyol plasticizer

c) up to 12% added water

d) 0.1 to 1.5% of a C_{12-22} fatty acid or salt

e) the balance being a [naturally] natural starch.